

REMARKS

Claims 25-28 currently appear in this application. The Office Action of March 23, 2004, has been carefully studied. These claims define novel and unobvious subject matter under Sections 102 and 103 of 35 U.S.C., and therefore should be allowed. Applicants respectfully request favorable reconsideration, entry of the present amendment, and formal allowance of the claims.

Specification

The disclosure is objected to because the specification is said to be still full of grammatical, idiomatic and/or typographical errors.

Applicant's attorney wishes to thank Examiner Wessendorf for the courtesies extended during the telephone interviews of May 26 and 28, 2004. During the interview of May 26, Examiner Wessendorf agreed that a substitute specification would be acceptable to correct the problems with the specification as filed. Accordingly, a substitute specification accompanies this amendment. The undersigned confirms that this substitute specification contains no new matter. During the interview of May 28, Examiner Wessendorf confirmed that the reference in the Office Action page 4 to page 22 and 23 of the specification was to the pages of the

amendments to the specification submitted with an amendment file June 5, 2003.

Rejections under 35 U.S.C. 101

Claims 21-24 are rejected under 35 U.S.C. 101 because the claimed invention is said to be not supported by either a specific asserted utility or a well-established utility.

This rejection is respectfully traversed. The present application is directed to making supported cDNA and gDNA libraries and replicas of these supported DNA libraries. DNA libraries are used extensively for genetic and other testing, and the present invention makes it possible to produce a number of exact replicas of a patient's gDNA or cDNA library so that only one sample need be taken. It should be noted that Takahashi et al., cited by the Examiner, describes immobilized gDNA and cDNA libraries and methods and apparatus for preparing such immobilized libraries for use in conventional PCR methods. The present invention relates to a method for making original and replica immobilized DNA libraries which can be used for gene amplification more than once without the requirement for obtaining additional samples from a patient.

Rejections under 35 U.S.C. 112

Claim 24 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

As the present amendment cancels claim 24, this rejection is now moot.

Claims 21-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This rejection is respectfully traversed. New claims 25-28 have been submitted, which claims it is believed better define the invention for which patent protection is sought.

Support for new claims 25-28 comes from the amended specification pages 22-24, including the essential features of the invention to which Examiner Wessendorf alluded in the Office Action of March 23, 2004.

Art Rejections

Claims 21-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Takahashi et al.

This rejection is respectfully traversed. Submitted herewith is a declaration under 37 CFR 1.132 of the inventors of the present application, two of whom are inventors of

Appln. No. 10/030,619
Amd. dated June 23, 2004
Reply to Office Action of March 23, 2004

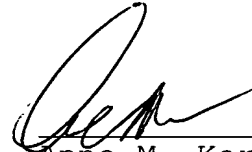
Takahashi et al., stating that any invention disclosed but not claimed in Takahashi et al. was derived from the inventors of the subject application and this is not an invention of "another"!

In view of the above, it is respectfully submitted that the claims are now in condition for allowance, and favorable action thereon is earnestly solicited.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.
Attorneys for Applicant

By



Anne M. Kornbau
Registration No. 25,884

AMK:msp
Telephone No.: (202) 628-5197
Facsimile No.: (202) 737-3528
G:\BN\T\TOYO\takahashi30\pto\28may04draftamd.doc



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTY.'S DOCKET: TAKAHASHI=30

In re Application of:)	Art Unit: 1639
Kojiro TAKAHASHI et al)	Examiner: T. D. Wessendorf
Appln. No.: 10/030,619)	Washington, D.C.
Filed: January 11, 2002)	Confirmation No. 8322
For: METHODS FOR CONSTRUCTING)	June 7, 2004
DNA LIBRARY AND SUPPORT)	
CARRYING DNA LIBRARY...)	

DECLARATION UNDER 37 CFR 1.132

Customer Window, Mail Stop
Honorable Commissioner for Patents
U.S. Patent and Trademark Office
2011 South Clark Place
Crystal Plaza Two, Lobby, Room 1B03
Arlington, Virginia 22202

Sir:

We, Kojiro Takahashi, Osamu Takai, and Michifurri Tanga, do hereby declare that we are inventors of the subject application. We further declare that two of us, Kojiro Takahashi and Michifumi Tanga, are the inventors of U.S. Patent No. 6,498,111, hereinafter "Takahashi et al."

The three inventors of the subject application were working to solve similar problems as those of Takahashi et al. with respect to producing supports for DNA library preparation and gene amplification. We believe that any invention disclosed but not claimed in Takahashi et al. was derived from

the inventors of the subject application, and is thus not the invention "by another" that would prevent patenting of the subject application.

We hereby further declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 81 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Kojiro Takahashi
Kojiro Takahashi

Osamu Takai
Osamu Takai

Michifumi Tanga
Michifumi Tanga